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EXAMINER

FREEMAN, JOHN D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERTO FORLONI and EUGENIO LONGO

Appeal 2010-006300
Application 10/565,868
Technology Center 1700

Before CHUNG K. PAK, MARK NAGUMO, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 15-36. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 15 is illustrative¹:

15. A multilayer, biaxially oriented, thermoplastic film comprising:

(A) a first outer layer comprising at least one member selected from the group consisting of polyester homopolymer and polyester copolymer;

(B) a second outer layer comprising at least one member selected from the group consisting of ethylene homopolymer, ethylene copolymer, propylene homopolymer, and propylene copolymer; and

(C) a first core layer comprising ethylene/vinyl alcohol copolymer; and wherein the multilayer film has a modulus, according to ASTM D882, of at least 6,000 kg/cm² in at least one direction, with the proviso that the multilayer film does not have a core layer containing at least 50 weight percent, based on layer weight, of at least one member selected from the group consisting of polyamide and polyester.

Appellants appeal the following rejections:

Claims 15-18, 27, and 28 under 35 U.S.C. § 102(b) as anticipated by Murata (US 4,496,714 (1985));

Claims 19-26, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over the combined prior art of Murata, Murschall, and Bassett (US 3,969,176 (1976));

Claims 29-31 under 35 U.S.C. § 103(a) as unpatentable over Murata;

Claims 32 and 33 under 35 U.S.C. § 103(a) as unpatentable over Murata in view of Laird (US 3,541,040 (1970)); and

Claim 34 under 35 U.S.C. § 103(a) as unpatentable over Murata in view of Banaszak (US 6,423,421 B1 (2002)).

¹ Claim 35 is a corresponding independent method claim.

ISSUE

Did the Examiner reversibly err in finding that Murata describes within the meaning of 35 U.S.C. § 102 a multi-layer thermoplastic film arranged as recited in independent claims 15 and 35?

We answer this question in the affirmative.

PRINCIPLES OF LAW

“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

ANALYSIS

with Factual Findings

Appellants argue that the Examiner has not shown how Murata anticipates either of independent claims 15 and 35 since there is only a “1-in-1152 chance of arriving at” the claimed invention from Murata’s disclosure (App. Br. 12; *see also* App. Br. 7-18, Reply Br. 2-5). Appellants also point out that since Murata does not anticipate the recited multi-layer construction, it does not inherently (that is, necessarily) possess the recited modulus “of at least 6,000 kg/m² in at least one direction” (App. Br. 18).

Notably, the Examiner does not dispute Appellants’ determination that there are 1152 possible species within the genus described by Murata, nor does the Examiner direct us to any specific example or disclosure in Murata that describes the claimed film and its claimed “modulus . . . of at

least 6,000 kg/m² in at least one direction” (claim 15, 35; *see* Ans. generally). The Examiner primarily relies upon the generic disclosure of Murata at col. 12, ll. 39-56:

The laminates may take the form of (B)/(A)/(C)/(D) wherein A is the polyester of Murata's invention (col. 12 ll. 39-56). (B) and (C) are “adherend layers” (col. 12 ll. 43-44), said adherend materials include ethylene-vinyl alcohol and polyester (col. 12 ll. 1-21). (B) can be polyethylene terephthalate, an aromatic polyester (col. 27 ll. 52-54). (D) can be polyethylene or polypropylene (col. 12 ll. 50-52).

(Ans. 3).

The deficiencies of this rejection for anticipation, which involves picking and choosing among various disclosures for all three layers required by the claim, were explained by the predecessor to the Federal Circuit nearly fifty years ago:

It is to be noted that rejections under 35 U.S.C. § 103 are proper where the subject matter claimed “is not identically disclosed or described” (emphasis ours) in “the prior art,” indicating that rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in “the prior art.” Thus, for the instant rejection under 35 U.S.C. § 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.

In re Arkley, 455 F.2d 586, 587-88 (CCPA 1972).

As for the modulus property required by claim 15, the Examiner “takes the position that the film described by Murata, which includes aromatic polyesters, inherently possesses the modulus properties disclosed by Applicant.” (Ans. 3). The Examiner has not, however, established any evidentiary basis showing that the presence of aromatic polyesters in the films described by Murata result in a modulus in at least one direction of at least 6000 kg/cm². See *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) [quoted in *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991)].

The Examiner does not rely upon any other reference to remedy the deficiency of Murata. Accordingly, we are constrained to reverse all of the rejections before us.

DECISION

We reverse the Examiner’s § 102 and 103 rejections.

ORDER

REVERSED

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